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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/721,652 | 11/25/2003 | Glenn R. Gibson | 8497-US | 7110 |

74476 7590 12/22/2009

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| EXAMINER | |
|---|---|
| BARHAM, BETHANY P | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1615 | |

| NOTIFICATION DATE | DELIVERY MODE |
|---|---|
| 12/22/2009 | ELECTRONIC |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdepartment@rd.nestle.com
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| Advisory Action Before the Filing of an Appeal Brief | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/721,652 | GIBSON ET AL. | |
| | Examiner | Art Unit | |
| | BETHANY BARHAM | 1615 | |

*--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

THE REPLY FILED 09 December 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

a) ☐ The period for reply expires _____months from the mailing date of the final rejection.

b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: _____.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.

12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____

13. ☐ Other: _____.

/Robert A. Wax/
Supervisory Patent Examiner, Art Unit 1615

Continuation of 11. does NOT place the application in condition for allowance because: Applicant's arguments are not persuasive. The Examiner respectfully suggests that the issues are ripe for appeal by Applicant.

Applicant continues to argue that the Examiner has confused written description with enablement, that a prophetic example of 'about 15 g to about 20 g' FOS and GOS is enough to enable use of the composition with claimed synergistic effect and that the presence of adverse events and teaching away of greater than 10 g of FOS/GOS as taught by the prior art is 'irrelevant', since the instant claimed invention results in 'synergisitic effects'. Applicant also argues there is burdensome experimentation to 'measur[e] about 15 to about 20 g of fiber'. The Examiner respectfully points out that while the instant specification does support (ie have written description for) the range 'about 15 g to about 20 g' and that measuring the amount of 'about 15 g to about 20 g' is capable of a person of skill in the art without undue burden, the prior art '124 teaches that such a composition in that amount is not 'useful' or capable of being 'used' and teaches against such a 'use' since it results in bad side effects at amounts greater than 10 g. The Applicant has not provided factual evidence in the form of a declaration, side-by-side comparison, etc with the closest prior art to show that the composition is 'useful' at amounts greater than 10 g or that the claimed synergisitic effects result at the higher amount of 'about 15 g to about 20 g'. Note enablement is made on the grounds of 'make' and 'use', the rejection of record that is maintained and at issue presently is enablement with respect to 'use'.

Further Applicant argues that the prior art rejection over Lesen et al in view of Van Leeuwen et al is in directed contrast to the instant claimed invention which requires higher amounts of FOS and GOS of 'about 15 g to about 20 g' (pg. 10-11 response). The Examiner respectfully points out that the rejection of Lesen et al in view of Van Leeuwen et al is only over claim 27, which does not contain the limitation of 'about 15 g to about 20 g' FOS and GOS and as such Applicant is arguing limitations of the specification into the claim. Both Lesen et al and Van Leeuwen et al teach FOS, GOS and mixtures thereof or one or more of prebiotic fibers including FOS and GOS (Lesen et al col. 4, lines 44-65 and col. 7, lines 23-25, claim 1 and 26, etc) and in view of Van Leeuwen et al which teaches glutamine included in a prebiotic fiber FOS/GOS containing composition (claims 1-2, 8 and 12). As such claim 27 remains rejected over Lesen et al in view of Van Leeuwen et al and the 'consists essentially of' language does not overcome the prior art as argued by Applicant since Applicant has not provided evidence that additional components would materially change the characteristics of the instantion as such the claim is treated as 'comprising' (see MPEP 2163).